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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,538	05/10/2002	Jonathan Quinton Kerr	FHW-099US	6206
959	7590	10/04/2004		
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			EXAMINER MARMOR II, CHARLES ALAN	
			ART UNIT 3736	PAPER NUMBER
DATE MAILED: 10/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/031,538	Applicant(s) KERR, JONATHAN QUINTON	
	Examiner Charles A. Marmor, II	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed May 17, 2004. The Examiner acknowledges the amendments to the specification, to the drawings, and to claims 1, 2, 4-6 and 9. Claims 1-10 are pending.

Drawings

2. The drawings were received on May 17, 2004. These drawings are acceptable.

Claim Objections

3. Claim 7 is objected to because of the following informalities: in line 1, --of barriers-- apparently should be inserted after "pack". Appropriate correction is required.
4. Claim 8 is objected to because of the following informalities: in line 1, --of barriers-- apparently should be inserted after "pack". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, the claim language renders the claim indefinite. Specifically, the limitation “the surface of each piece... opposing the *at least one* sterile surface” is indefinite. It is unclear how many surfaces each piece has, and if each piece were to have a plurality of surfaces, what surface would be in opposition to the sterile surface(s).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 5-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Price ('590). Price teaches a pack of barriers that are capable of use in relation to an eye contacting optical testing apparatus. The pack includes a plurality of barriers **10** formed from pieces of substantially transparent film that have dimensions comparable to those of an eye-contacting surface of a tonometer probe. The barriers are removably attached to a first backing sheet **13b**. A surface of each barrier film **10** adjacent the first backing sheet **13b** is sterile. The opposite surface of each barrier film is provided with a peelable adhesive material **12**. The plurality of barriers **10** and the first backing sheet **13b** are adhered to a second backing sheet **13a** in part by the peelable adhesive material **12**. The backing sheets are provided with weakened perforated lines that allow portions of the backing sheets surrounding one or more barriers to be separated by tearing. Each barrier is provided with an adhesive-free tab **11** for easy removal of the barrier.

Allowable Subject Matter

9. Claims 2-4 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 2-4, the prior art of record does not teach or suggest modifying the pack of barriers of Price ('590) to provide the first backing sheet with locating means, colored markers or colored rings for locating the head of the probe of an optical testing apparatus.

Regarding claim 8, Price ('590) teaches away from providing the tabs with any adhesive substance that would be capable of retaining the barrier on the head of a probe.

Response to Arguments

11. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection. Applicant contends that Brady does not teach a plurality of barriers in which the alternative surface is provided with a peelable adhesive, and that the Brady actually teaches away from such a feature. Applicant further argues that Makita fails to teach or suggest a plurality of barriers in which the surface adjacent the first backing sheet is sterile and the alternative surface is provided with a peelable adhesive. These arguments have been considered but are moot in view of the new grounds of rejection citing Price set forth hereinabove.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ohmes ('386) teaches a disposable transparent cover for a dental mirror.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II
Primary Examiner
Art Unit 3736

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September 30, 2004